

REMARKS

This application has been carefully reviewed in light of the Office Action dated July 30, 2003. Claims 1-3 remain pending in this application. Claim 1 is the independent claim.

In response to the Office Action's objection to the drawings under 37 CFR 1.83(a), Applicant respectfully believes the amendment to Claim 1 renders the objection moot. Applicant respectfully requests withdrawal of the objection to the drawings.

On the merits, the Office Action rejected Claims 1-4 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant respectfully believes the amendments to Claims 1-3 and the cancellation of Claim 4 adequately respond to the rejections and respectfully requests theirs withdrawal.

Further on the merits, the Office Action rejected Claims 1 and 4 under 35 U.S.C. § 102(e) as being anticipated by Gandhi et al. (U.S. Patent No. 6,448,631; hereinafter "Gandhi"). The Office Action also rejected Claims 2-3 under 35 U.S.C. § 103(a) as being unpatentable over Gandhi. Applicant respectfully submits that the claims are allowable for at least the following reasons:

Applicant's Claim 1 recites: "An integrated circuit provided with at least one output driver (4) without substrate contacts and

further provided with at least a core region with a Vssc contact (7, 9) and a periphery region provided with at least one Vssq contact (8), characterized in that a resistance (11) with a value lying between 100 and 300 ohms is provided between each Vssq contact (8) and the Vssc contact (7, 9)."

The Office Action argues that the Vssc and Vssq contacts have a resistance which inherently exists and its value depends upon the distance of the two contact points. Applicant respectfully notes that a missing element is inherently present in a reference only if that element necessarily follows from what has been expressly described, and would be so recognized by one of skill in the art (as opposed to the examiner's expectation). Mere possibilities or even probabilities are not enough; necessity recognized by those of skill in the art is required.¹ The M.P.E.P. echoes this case law.

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.

M.P.E.P. § 2112 (emphasis in original) (citations omitted).

Further, the following is also emphasized:

¹ The Federal Circuit has clearly set out the standard for inherency in, e.g., Continental Can Co. v. Monsanto Co., 20 U.S.P.Q.2d 1746, 1749 (Fed. Cir. 1991)(emphasis added):

To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference and that it would be so recognized by persons of ordinary skill. In re Oetrich, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981) (quoting Hansgirk v. Kemmer, 40 U.S.P.Q. 665, 667 (C.C.P.A. 1939)) provides: "Inherency, however may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient."

This citation is also set out in M.P.E.P. § 2131.01(d).

In relying upon the theory or inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teaching of the applied prior art.

M.P.E.P. § 2112 (emphasis in original) (citations omitted).

It is well established that a recited element or step is inherently present in a prior art reference only if that element is necessarily present or necessarily performed in that reference, and further that its presence or performance would be recognized by one of ordinary skill in the art from what has been expressly described. Second, the Office Action must provide objective evidence or cogent technical reasoning to support a contention of inherency.²

Nothing found in Gandhi recites or suggests an IC with a core region with a Vssc contact and a periphery region with a Vssq contact where a resistance between 100 and 300 ohms is provided between each Vssq contact and Vssc contact. The mere possibility is insufficient to support an inherency argument. Contrary to the Office Action's argument that distance inherently dictates the resistance, the provided resistance has novel and non-obvious advantages (such as reduced noise) which one of ordinary skill in the art at the time of the invention would not have recognized.

Additionally, Gandhi fails to recite or suggest the structural

² "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex Parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

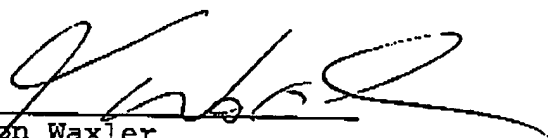
limitation of a provided resistance. No resistance is shown in Gandhi except for that created by distance. Thus, Claim 1 is believed patentable over Gandhi for at least these reasons.

Claims 2-3 depend from independent Claim 1 discussed above and are believed patentable for at least the same reasons. In addition, Applicant respectfully believes Claims 2-3 to be independently patentable and request separate consideration of each claim. Applicant respectfully believes the § 103 rejection of Claims 2-3 to be moot in light of the above remarks and requests its withdrawal.

In view of the foregoing remarks, Applicant respectfully requests favorable reconsideration and early passage to issue of the present application.

Applicant's undersigned agent may be reached by telephone at the number given below.

Respectfully submitted,

BY 
Aaron Waxler,
Reg. 48,027
(914) 333-9608
October 30, 2003